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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,008	07/31/2001	Kurt E. Spears	10013070-1	3181

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EXAMINER

LUU, THANH X

ART UNIT PAPER NUMBER

2878

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,008

Applicant(s)

SPEARS ET AL.

Examiner

Thanh X Luu

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,9,11,12,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,9,11,12,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on March 12, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3, 4, 9, 11 and 12 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear where Applicant discloses an embodiment in which an optical head is displaced from a platen. As understood, in Fig. 2, since the elements 206 and 106

are part of the optical head, the optical head is never displaced from the platen. Rather, it appears that the optical head tilts or pivots on 206. Thus, the optical head always touches the platen and therefore is not displaced from the platen by a first or a second distance. Further, it is unclear how the distances are different. Fig. 2 shows the optical head at a constant distance or the same distance since the optical head pivots on 206. That is, the optical head is not displaced from the platen by a different distance for a second direction of travel and the distance is not dependent on a direction of translation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 9, 12, 17 and 18, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (JP 11-341219, published December 10, 1999).

Regarding claims 1 and 4, Takahashi discloses (see Fig. 7) a scanner, comprising: a platen (1); and an optical head (2) that travels substantially parallel to the platen, the optical head displaced (tilted) from the platen by a first distance for a first direction of travel and by a different distance for a second direction of travel. Takahashi also discloses (see Fig. 7) pads (not labeled) positioned between the optical head and the platen, wherein the optical head pivots around at least some of the pads, the optical

head pivots to a first position for the first direction of travel and a second position for a second direction of travel.

Regarding claim 9, Takahashi discloses (see Fig. 7) a method of scanning, comprising: translating an optical head (2) in a direction substantially parallel to a platen, and adjusting a distance (tilt) of the optical head relative to the platen, wherein the distance is dependent on a direction of translation of the optical head. That is, as the optical head is translated in an opposite direction, the optical head would inherently tilt the other way at another distance.

Regarding claim 12, Takahashi discloses (see Fig. 7) a method of scanning, comprising: translating an optical head (2); and pivoting the optical head around a pad (not labeled), the pad between the optical head and a platen, where a direction of pivoting (tilt) is dependent on a direction of translating, and wherein the distance between the optical head and the platen is a function of the direction of pivoting of the optical head.

Regarding claim 17, Takahashi discloses (see Fig. 7) a scanner comprising: a photosensor array (5); a platen (1); and means for changing (pads, translating means) a distance of the photosensor array relative to a surface of the platen, dependent on a direction of translation of the photosensor array.

Regarding claim 18, Takahashi discloses (see Fig. 7) a scanner comprising: a platen (1); a photosensor array (5), the photosensor array being translated substantially parallel to the platen, where a first direction of translation causes the photosensor array to be displaced from the platen a first distance, and where a second direction of

translation causes the photosensor array to be displaced from the platen at a different distance. That is, since the photosensor array is located off-centered, the optical head would tilt the other way when it is translated in the opposite direction, causing a change of different distances.

Allowable Subject Matter

6. Claims 3 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if the 112 rejections are overcome and rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: a scanner and method as claimed, more specifically in combination with pivoting a pad or pads pivoting around a pivot point, is not disclosed or made obvious by the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X Luu whose telephone number is 571-272-2441. The examiner can normally be reached on M-F 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on 571-272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thanh X Luu
Primary Examiner
Art Unit 2878

04/04